

0018-1086-0 PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Hiroshi MIYAKE, ET AL.

SERIAL NO: 09/446,145

FILED: January 7, 2000



: EXAMINER: PATEL, S.

GROUP ART UNIT: 1624

FOR: AROYL-PIPERAZINE  
DERIVATIVES, THEIR  
PREPARATION AND THEIR  
USE AS TACHYKININ  
ANTAGONISTS

#16  
6/18/00  
NW

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

Responsive to the Official Action dated May 18, 2000, Applicants elect Group I with traverse. In addition, as an ultimate single disclosed species, Applicants provisionally elect the species named in Example 73-(2) on page 151 of the specification, which is (2R)-1-[3,5-Bis(trifluoromethyl)benzoyl]-4-[4-((3S)-3-ethylmorpholino)-2-butynyl]-2-[(1H-indol-3-yl)methyl]piperazine dihydrochloride. Claims 1-10 read on the elected species.

REQUEST FOR RECONSIDERATION

The Office has restricted this application under 35 U.S.C. §121 and 372.

In response, Applicants have elected Group I with traverse. In addition, as an ultimate single disclosed species, Applicants have provisionally elected the species named in Example 73-(2) on page 151 of the specification, which is (2R)-1-[3,5-Bis(trifluoromethyl)benzoyl]-4-

[4-((3S)-3-ethylmorpholino)-2-butynyl]-2-[(1H-indol-3-yl)methyl]piperazine dihydrochloride. Claims 1-10 read on the elected species.

The Office, citing PCT Rules 13.1 and 13.2, contends that the claims lack unity of invention because "they represent different cores and use."

The restriction and election requirements are respectfully traversed. Applicants note that the PCT administrative instructions in the MPEP, Annex B, Part 1(f) define Markush practice and state that the alternatives defined in a single claim shall meet the technical relationship requirements of PCT Rule 13.2 if they are of a similar nature. These alternatives shall be regarded as being of a similar nature when the following criteria are fulfilled:

(A) all the alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The Office provides no support for its conclusion that the alternative chemical compounds in the claims are so dissimilar that they fail to meet the requirements of PCT Rule 13.2 for Markush practice. Applicants respectfully submit that each of criteria (A) and (B) is met by the compounds under the claims and that they are of similar nature as that term is defined in Annex B above. Accordingly, Applicants respectfully submit that the restriction and election requirements are improper and respectfully request that they be withdrawn.

Applicants respectfully traverse the restriction and election of species requirements on the additional ground that the Office has not shown that a burden exists in searching all of the claims. MPEP §803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Applicants respectfully submit that, should no prior art be found which anticipates or makes obvious the elected species, the Office should expand its search to include the non-elected species. MPEP §803.02.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited. Should the Examiner have any questions regarding the elected species or otherwise wish to discuss this application, he is respectfully invited to contact Applicants' below-signed U.S. representative by telephone, who would be happy to assist in expediting any further prosecution deemed necessary in this case.

Respectfully submitted,

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Docket No.: 0018-1086-0 PCT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/446,145  
Applicants: Hiroshi MIYAKE, et al.  
Filing Date: January 7, 2000  
For: AROYL-PIPERAZINE DERIVATIVES, THEIR  
PREPARATION AND THEIR USE AS  
TACHYKININ ANTAGONISTS  
Group Art Unit: 1624  
Examiner: PATEL, S.

SIR:

Attached hereto for filing are the following papers:

## RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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